

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed November 24, 2003 ("Office Action"). At the time of the Office Action, Claims 4, 5, 10, 13-14, 16, 20-21, and 25 were pending and Claims 4, 5, 13-14, and 20-21 were allowed. In the Office Action, the Examiner rejects Claims 10, 16, and 25.

Summary of Telephonic Interview

Applicant's attorney, Mr. Samir A. Bhavsar, conducted a telephonic interview with Examiner Myhre and Mr. Robert Weinhardt on January 6, 2004. Pursuant to M.P.E.P. § 713.04, Applicant submits this summary of the telephonic interview to record Applicant's understanding of the substance of the interview. If Applicants' understanding is inaccurate, notice of such is appreciated. Attorneys for Applicant thank the Examiner for the courtesy of his telephonic interview. During the interview, the date on which the *Itakura* reference qualifies as art was discussed. Although no agreement was reached, the Examiner agreed to reconsider this issue in view of the following remarks.

Section 103 Rejections

The Examiner rejects Claims 10, 16, and 25 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,675,745 issued to Oku et al. ("Oku") in view of U.S. Patent No. 5,410,344 issued to Graves et al. ("Graves"), U.S. Patent No. 5,499,340 issued to Barritz ("Barritz"), and U.S. Patent No. 6,351,745 issued to Itakura et al. ("Itakura"). Applicant respectfully requests reconsideration and allowance of Claims 10, 16, and 25.

Itakura qualifies as art for purposes of 35 U.S.C. § 103(a) only under 35 U.S.C. § 102(e) because the issue date of *Itakura*, February 26, 2002, is subsequent to the filing date of the pending application, January 16, 1997. However, the § 102(e) date of *Itakura* is August 27, 1998 which is also subsequent to the filing date of the pending application, January 16, 1997. The M.P.E.P. contains a number of provisions which make clear that the § 102(e) date of *Itakura* for prior art purposes is August 27, 1998 – not August 19, 1996 as stated by the Examiner.

1) M.P.E.P. § 706.02(f)(1), Example 6 makes clear that the § 102(e) date of *Itakura* for prior art purposes is August 27, 1998. Example 6 addresses "References based on the national stage (35 U.S.C. 371) of an International Application filed prior to November 29, 2000"

which is exactly on point in order to determine the prior art date of *Itakura*. In particular, the U.S. Patent Application that eventually issued as *Itakura* entered the national stage in the United States according to 35 U.S.C. § 371 on August 27, 1998 through an International Application (e.g., PCT Application) that was filed on February 26, 1997 (before November 29, 2000). Therefore, Example 6 squarely applies to *Itakura*. According to Example 6, a reference U.S. Patent that issued from an international application that was filed on November 29, 2000 – such as *Itakura* – has a 35 U.S.C. § 102(e) prior art date of the date of fulfillment of the requirements of 35 U.S.C. § 371(c)(1), (2) and (4). Example 6 makes clear that this is the pre-AIPA 35 U.S.C. § 102(e). The date on which the 35 U.S.C. § 371 requirements were fulfilled for *Itakura* is August 27, 1998. Therefore, according to the rules illustrated in Example 6, the §102(e) date of *Itakura* is August 27, 1998.

Example 6 also addresses the situation where the reference U.S. patent claims additional priority or benefit of an earlier provisional application, as was done in *Itakura*. Example 6 makes clear that even if the application properly claimed the priority / benefit to any earlier filed U.S. application (whether provisional or nonprovisional), the 35 U.S.C. § 102 (e) date would still be the date the 35 U.S.C. § 371 requirements were fulfilled. With respect to *Itakura*, the 35 U.S.C. § 102(e) is still August 27, 1998 despite the references to U.S. provisional application nos. 60/022,171 and 60/023,577 filed July 15, 1996 and August 19, 1996, respectively.

2) M.P.E.P. 706.02(f)(1) III illustrates a Flowchart for determining the 35 U.S.C. § 102(e) dates of various references. The first block of the flowchart asks “Is the reference a U.S. patent or U.S. application publication of an International Application (IA)?”. The answer to this question applied to *Itakura* is “yes” because *Itakura* stemmed from a PCT application and entered national stage in the U.S. according to 35 U.S.C. § 371. The next block of the flowchart asks, “Was the IA filed on or after Nov. 29, 2000?” The answer to this question applied to *Itakura* is “no” because the PCT application was filed February 26, 1997 which is before November 29, 2000. The next block of the flowchart states that “For a patent: § 102(e) date is the § 371(c)(1), (2) and (4) date.” In the case of *Itakura*, the § 371(c)(1), (2) and (4) date is August 27, 1998. Therefore, the § 102(e) date of *Itakura* is August 27, 1998.

3) Pursuant to M.P.E.P. 2136.03(III) Priority From Provisional Application Under 35 U.S.C. 119(e), “...international applications which (1) were filed prior to November 29, 2000 ... may not be used to reach back (bridge) to an earlier filing date through a priority or benefit claim for prior art purposes under 35 U.S.C. 102(e).” The PCT Application filed on February

26, 1997, upon which *Itakura* is based, is the “international application” referred to in M.P.E.P. 2136.03(III). Therefore, although *Itakura* references U.S. provisional application nos. 60/022,171 and 60/023,577 filed July 15, 1996 and August 19, 1996, respectively (*see e.g.*, application data on face of *Itakura*), these dates are not effective dates for purposes of establishing *Itakura* as “prior art.”

Therefore, the § 102(e) date of *Itakura* is August 27, 1998. Because August 27, 1998 is later than the filing date of the pending application, January 16, 1997, *Itakura* does not qualify as “prior art” and its use in this rejection is improper. Applicant also traverses the Examiner’s interpretation of *Itakura* and reserves the right to discuss distinctions between Claims 10, 16, and 25 and the *Oku-Graves-Barritz-Itakura* combination, if necessary. For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claims 10, 16, and 25.

CONCLUSION

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Samir A. Bhavsar, Attorney for Applicant, at the Examiner's convenience at (214) 953-6581.

Although no fees are believed due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 05-765.

Respectfully submitted,

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